

REMARKS

Upon entry of this Response, claims 1, 6, 9, 11, and 14 will be amended, and claim 15 will be canceled. Thus, claim 1-14 will remain pending. No new matter has been added. Support for the changes to claims 6 and 9 may be found, for example, in FIG. 6 and the specification at page 11, line 26 to page 12, line 3 as originally filed. Reconsideration and further examination are respectfully requested in view of the following Remarks.

Specification

As a preliminary matter, please note that the Specification has been amended to include Application Nos. of cases referred to in the CROSS-REFERENCE TO RELATED APPLICATIONS section.

Claim Rejections – 35 USC 103

Claims 1-14 are rejected under 35 USC 103 as being unpatentable over Skillen (US Patent No. 6,098,065) in view of Rakavy (US Patent No. 5,913,040).

As amended, claim 1 recites “locally determining at a user device contextual information associated with remote information being accessed by a user.” By way of example, an advertising application 114 executing at a user device 110 (e.g., a user’s personal computer) might determine that a user has provided a query to a remote search engine (e.g., specification at page 8, lines 11 to 23).

Skillen discloses that an advertising machine 30 (including a contextual database 46, product database 42, and user profile database 48) at an access provider equipment site 32 may determine contextual information (Skillen at FIG. 2 and col. 5, lines 18 to 28).¹ That is, the

¹ FIG. 1 of Skillen similarly discloses that contextual information is determined remote from (and not local to) an end user device 12. That is, the determination is made on the other side of the communications link 14.

contextual information is not determined at the end user device 12 (as might be the case in the method of claim 1 of the present application).

Rakavy also does not disclose “locally determining at a user device contextual information associated with remote information being accessed by a user.”

Moreover, in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references,” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir.1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

Applicants respectfully suggest that the Examiner has not provided a reasonable motivation to modify Skillen and/or Rakavy in such a way as to result in the invention as recited in the claims. According to the Office Action:

It would have been obvious to one of ordinary skill ... to modify Skillen to include determining advertising information locally, as disclosed in Rakavy, because it would advantageously allow [the system] to present advertisements to the user in accordance with preconfigured user preference information.

Office Action at page 3, fourth paragraph. Applicants respectfully disagree and suggest that these references in no way suggest modifying any system to produce a method as recited in claim 1. Instead, the Office Action merely points one of the benefits that may be provided by the present invention. Because there is no teaching or suggestion to modify the references in the particular way recited in claim 1, a *prima facie* case of obviousness has not been established.

Because the references do not disclose or suggest such a feature, Applicants respectfully request allowance of claim 1. The remaining claims depend from claim 1 or contain similar limitations and should therefore be allowable for at least the same reasons.

In addition, claim 6 now recites locally determining “a dynamically adjusted screen display position” and providing advertising information to a user at that position (e.g., as illustrated by FIG. 6 and described in the specification at page 11, line 26 to page 12, line 3 as originally filed). Neither Skillen nor Rakavy disclose or suggest such a feature and this is an additional reason why claim 6, and claims 7-10 dependent thereon, should be allowed.

Further, claim 11 now recites locally determining “a search term associated with remote information being accessed by a user” and providing advertising information to a user based on that search term. Neither Skillen nor Rakavy disclose or suggest such a feature and this is an additional reason why claim 11, and claims 12-14 dependent thereon, should be allowed.

CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-0191.

Respectfully submitted,

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Date

/Patrick J. Buckley/
Patrick J. Buckley
Registration No. 40,928
Buckley, Maschoff & Talwalkar LLC
50 Locust Avenue
New Canaan, CT 06840
(203) 972-0191